

## REMARKS

The Application has been reviewed in light of the Office Action mailed April 6, 2005. At the time of the Office Action, Claims 44-63 were pending. Claims 1-43 were previously cancelled by Applicants. Claims 44-63 are rejected. Applicants amend Claims 46-48, 52, and 55 and respectfully request reconsideration and favorable action in this case.

### Claim Objections

Claims 46-48, and 52 were objected to by the Examiner because of informalities. Applicants have amended Claims 46-48, and 52 to overcome these objections.

Applicants also have amended Claim 55 to fix a typographical error consisting of repeated words.

### Rejections under 35 U.S.C. §103

Claims 44-63 were rejected under 35 U.S.C. §103(a) as being unpatentable as follows:

- Claims 44-47 were rejected over *Upgrading & Fixing PCs for Dummies: 4th Edition* by Andy Rathbone (“Rathbone”) in view of *The Complete Idiot’s Guide to PCs: 6th Edition* by Joe Kraynak (“Kraynak”).
- Claim 48 was rejected over Rathbone and Kraynak, as with Claim 44, and in further view of *Integrating Old PCs Back Into Society* by Karen Kaplan (“Kaplan”).
- Claim 49 was rejected under 35 U.S.C. §103(a) as being unpatentable over Rathbone, Kraynak and Kaplan, as with Claim 48, and in further view of *A PC Buyer’s Primer* by Edward N. Siguel (“Siguel”).
- Claim 50 was rejected over Rathbone, Kraynak, and Kaplan, as with Claim 48, and in further view of U.S. Patent No. 6,012,045 issued to Nizan Barzilai et al. (“Barzilai et al.”).
- Claim 51 was rejected over Rathbone and Kraynak, as with Claim 44, and in further view of *Getting Personal: A Growing Number of Computer-Buyers Are Opting For Made-to-Order Machines* by Preston Sparks (“Sparks”).
- Claims 52-56 were rejected over Rathbone and Kraynak, as with Claim 44, and in further view of *Are You Y2K Complaint* by Anonymous (“Anonymous”).
- Claim 57 was rejected over Rathbone, Kraynak and Anonymous, as with Claim 53, and in further view of Barzilai et al.
- Claims 58-60 and 62-63 were rejected over Rathbone, Kraynak, Kaplan, Siguel and Sparks.

- Claim 61 was rejected over Rathbone, Kraynak, Kaplan, Siguel, Sparks, and Barzilai et al.

Applicants respectfully traverse and submit that the cited art combinations, even if proper, which Applicants do not concede, do not render the Claimed embodiment of the invention obvious.

A *prima facie* case of obviousness requires a showing that all of the Claim limitations of the rejected Claims are taught or suggested by the prior art. MPEP § 2143. Furthermore, if any Claim is nonobvious under 35 U.S.C. § 103, then any Claim depending therefrom is nonobvious. MPEP § 2143.01. Accordingly, if Applicants' independent Claims 44, 53, and 58 are nonobvious, then all remaining Claims, are nonobvious, because they depend on from a nonobvious dependent Claim.

**1. The Rathbone-Kraynak combination does not teach or suggest all limitations of Claim 44, 45, and 47.**

Even if the Rathbone-Kraynak combination was proper, which Applicants do not concede, Rathbone-Kraynak does not teach or suggest each limitation of Applicants' independent Claim 44, from which Claims 45 and 47 depend. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established for Claims 44, 45, and 47.

The Examiner has stated that Rathbone discloses a method comprising "comparing the new hardware configuration data and the old hardware configuration data." Office Action at 4. As the Examiner has noted, the cited portion of Rathbone discusses "dissect[ing] that old 486 for parts[,] [including] [y]ank[ing] out the old video card, or buy[ing] and new one if the old card isn't PCI compatible . . . [g]rab[bing] the monitor and then attach[ing] it and the video card to your new computer." *See* Rathmore, page 163. The cited portion of Rathmore neither teaches or suggests "electronically comparing the new hardware configuration data and the old hardware configuration data," are required by Claims 44, 45, and 47. Rather, it discusses "yank[ing]/buy[ing]," "grab[bing]" and "attach[ing]," none of which disclose "comparing the new hardware configuration data and the old hardware configuration data," as required by the Claims.

The Examiner has also asserted that "comparing the old hardware configuration and new hardware configuration would be inherent in determining which components from the

old computer system could be reused in the new computer system.” Applicants’ respectfully submit, however, that the Examiner has not provided a basis in fact and/or technical reasoning to reasonably support the determination of inherency. *See* MPEP § 2112 (“The fact that a certain result of characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.”).

The Examiner stated that Rathbone discloses “determining a compatible component list indicating which components of the old computer system may be reused in the new computer system.” *See* Office Action, page 5. Applicants, however, respectfully disagree. To show this limitation, the Examiner again cites to the “yank[ing]/buy[ing],” “grab[bing]” and “attach[ing],” portion of Rathbone quoted and discussed above, which does not disclose “determining a compatible component list indicating which components of the old computer system may be reused in the new computer system,” as required by the Claims.

The Examiner further stated that “determining compatibility of components would be inherent in reusing components from old computer system in new computer system.” Applicants’ respectfully submit, however, that the Examiner has not provided a basis in fact and/or technical reasoning to reasonably support the determination of inherency. *See* MPEP § 2112 (“The fact that a certain result of characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.”).

The Examiner has not cited any portion of Rathbone or Kraynak to show the following limitations, which are recited by Applicants’ Claim 44:

- accessing a first manufacturer’s database, wherein accessing includes logging onto the storefront database from a first computer network;
- requesting information from an old computer system using a configuration request;
- receiving old configuration data from the old computer system from the first manufacturer’s database;
- highlighting any components of the old computer system identified by the configuration utility software as differing from the old system configuration; and
- altering the old system configuration to reflect any different components identified by the configuration utility software.

Unless each element of the Claim is taught or suggested, an obviousness rejection is improper. Here, because the combination of Rathbone and Kraynak does not teach or suggest the elements of Claim 44 listed above, the rejection of Claim 44 should be withdrawn and Claim 44 should be passed to issuance. Each of Claims 45-47 depend from Claim 44, which

Applicants have shown to be patentable. Therefore, Applicants request that the rejections of Claim 45-47 be withdrawn and the Claims passed to issuance.

**2. The Combination of Rathbone, Kraynak, and Anonymous  
Do Not Teach or Suggest All Limitations of Claim 53**

Even if Rathbone, Kraynak, and Anonymous could be combined for the sake of the obviousness rejection asserted by the examiner, the combination of Rathbone, Kraynak, and Anonymous does not teach or suggest each element of the rejected Claims. Applicants respectfully submit that a *prima facie* case of obviousness has not been established for Claim 53.

Here, all of the elements of the independent Claim 53 are not shown in the combination of Rathbone, Kraynak, and Anonymous. For example, neither Rathbone, Kraynak, nor Anonymous explicitly teach or suggest a method comprising:

- obtaining old configuration data over a first computer network for an old computer system from a first manufacturer using a unique tag that uniquely identifies the old computer system;
- obtaining new configuration data over a second computer network for a new computer system from a second manufacturer; and
- determining a compatible component list indicating at least one component of the old computer system that is reusable in the new computer system.

Unless each element of the Claim is taught or suggested, an obviousness rejection is improper. Here, for the same rationale as applied for passing Claim 44 and because the combination of Rathbone, Kraynak, and Anonymous does not teach or suggest the elements of Claim 53 listed above, the rejection of Claim 53 should be withdrawn and Claim 53 should be passed to issuance. Each of Claims 54-57 depend from Claim 53, which Applicants have shown to be patentable. Therefore, Applicants respectfully request that the Examiner withdrawn the rejections of Claim 54-57 and pass the Claims to issuance.

**3. The Combination of Rathbone Kraynak, Kaplan, Siguel,  
and Sparks Do Not Teach or Suggest All Limitations of Claim 58**

Even if Rathbone Kraynak, Kaplan, Siguel, and Sparks could be combined for the sake of the obviousness rejection asserted by the examiner, the combination of Rathbone Kraynak, Kaplan, Siguel, and Sparks does not teach or suggest each element of the rejected

Claims. Applicants respectfully submit that a *prima facie* case of obviousness has not been established for Claim 58.

Here, all of the elements of the independent Claim 58 are not shown in the combination of Rathbone Kraynak, Kaplan, Siguel, and Sparks. For example, neither Rathbone Kraynak, Kaplan, Siguel, nor Sparks explicitly teach or suggest a method comprising:

- obtaining old configuration data over a first computer network for an old computer system from a first manufacturer using a unique tag that uniquely identifies the old computer system;
- obtaining new configuration data over a second computer network for a new computer system from a second manufacturer; and
- determining a compatible component list indicating at least one component of the old computer system that is reusable in the new computer system.
- determining the street prices of the old computer system with and without the reusable component;
- determining the prices of the new computer system with and without the reusable component;
- computing transaction amounts with and without reuse of the reusable component, the transaction amount equal to the new computer price minus the old price; and
- selecting the lowest transaction amount.

Unless each element of the Claim is taught or suggested, an obviousness rejection is improper. Here, for the same rationale as applied for passing Claim 44 and because the combination of Rathbone Kraynak, Kaplan, Siguel, and Sparks does not teach or suggest the elements of Claim 58 listed above, the rejection of Claim 58 should be withdrawn and Claim 58 should be passed to issuance. Each of Claims 59-63 depend from Claim 58, which Applicants have shown to be patentable. Therefore, Applicants respectfully request that the Examiner withdrawn the rejections of Claim 59-63 and pass the Claims to issuance.

**B. There is No Suggestion or Motivation to Modify the Reference or to Combine Reference Teachings**

**1. There is No Suggestion or Motivation to Modify or to Combine Rathbone and Kraynak to Establish a *Prima Facie* Case of Obviousness for Claim 44**

Even if the combination of Rathbone and Kraynak did teach or suggest each element of the rejected Claims, which applicants have shown is not the case, there is no suggestion or motivation to modify or to combine Rathbone and Kraynak to establish a *prima facie* case of obviousness for Claim 44.

**A. Modifying Rathbone Not Obvious to One of Ordinary Skill**

The Examiner states that:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone by incorporating the ability to request configuration data from the manufacturer's database to provide an additional avenue through which to secure configuration data of the old computer system. (see Office Action, p. 6)

Applicants respectfully submit that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone to provide a method comprising the elements of Claim 44. Examiner states that Rathbone "suggests multiple avenues through which to secure such information such as through examination of old computer manuals and sales receipts, and executing configuration utility software." (see Office Action, p. 6) Rathbone, as shown by the portion of Rathbone presented by the Examiner, does not contain a suggestion or motivation to modify Rathbone to meet the elements Claim 44. Rathbone does discuss multiple avenues and none of the avenues suggest or show a motivation to incorporate the ability to request configuration data from the manufacturer's database.

The Examiner also states that "whether the old computer system accesses an external database or an internal database to obtain the configuration data, the user would still have to access the same configuration data." *See* Office Action, page 6 The Examiner, however, does not provide any citation to art for this statement. Applicants respectfully request that the Examiner provide documentation for this statement, or if the statement is based on personal knowledge, an affidavit stating that such a teaching is within the personal knowledge of the Examiner.

Applicants respectfully submits that the Examiner has not shown that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone to provide a method comprising the above elements, and therefore a *prima facie* case of obviousness has not been established.

**B. Modifying Rathbone by Incorporating Kraynak Not Obvious to One of Ordinary Skill**

**The** Examiner states:

It would have been obvious to a person or ordinary skill in the art at the time of the invention was made to have modified Rathbone by incorporating the ability to retrieve configuration data from a new computer, as illustrated by Kraynak, to ensure the components from the old computer system would be compatible with the new computer system. (see Office Action, p. 7)

Applicants respectfully submit that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone to provide a method comprising the elements of Claim 44. The examiner does not give any reason why it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone. There is no suggestion or motivation to modify the reference or to combine reference teachings.

Furthermore, the Examiner states:

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have automated the method of retrieving information, comparing and determining component compatibility because it would have sped up the process, which was known, and the end result would have been the same as compared to the manual method. *In re Venner*, 262 F.2d 91, 95 1209 USPQ 193, 104 (CCPA 1958). (see Office Action, p. 7)

Applicants respectfully submit that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone to provide a method comprising the elements of Claim 44. The Examiner does not give any reason why it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone.

**2. There is No Suggestion or Motivation to Modify or to Combine Rathbone, Kraynak, and Anonymous to Establish a Prima Facie Case of Obviousness for Claim 53**

Even if the combination of Rathbone and did teach or suggest each element of the rejected Claims, which applicants have shown is not the case, there is no suggestion or motivation to modify or to combine Rathbone, Kraynak, and Anonymous to establish a prima facie case of obviousness for Claim 53. The Examiner states, which respect to Claim 52, that:

[i]t would have been obvious to have incorporated into Rathbone and Kraynak the labeling of the configuration request with a unique tag corresponding to the old computer system, as illustrated by Anonymous, to properly and accurately link the configuration request to the user's specific old computer system. *See Office Action, page 13.*

Applicants respectfully disagree that such a combination would have been obvious. The Examiner does not cite any discussion in any of the reference to support why it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Rathbone and Kraynak. There is no suggestion or motivation to modify the reference or to combine reference teachings.

**3. There is No Suggestion or Motivation to Modify or to Combine Rathbone Kraynak, Kaplan, Siguel, and Sparks to Establish a Prima Facie Case of Obviousness for Claim 58**

Even if the combination of Rathbone and did teach or suggest each element of the rejected Claims, which applicants have shown is not the case, there is no suggestion or motivation to modify or to combine Kraynak, Kaplan, Siguel, and Sparks to establish a prima facie case of obviousness for Claim 58. The Examiner states that:

[i]t would have been obvious to have incorporated into Rathbone, Kraynak, Kaplan and Siguel the ability to modify and order a new computer system configuration, as illustrated by Sparks, to accomodate the possible reuse of components from the old computer system, as illustrated by Rathbone, to reduce the cost of a new computer system. *See Office Action, page 15.*

Applicants respectfully disagree. The Examiner does not cite any discussion in any of the reference to support this conclusion. Therefore, the Examiner's rationale for combination appears to be based solely on hindsight, and is therefore improper.

## CONCLUSION

For the foregoing reasons, Applicants request that Claims 44-63, as amended, be allowed. Early and favorable acceptance of this application is respectfully requested.

Applicants believe no fees are due, however, should any fees be due the Commissioner is hereby authorized to charge any fees to Deposit Account No. 02-0383 of Baker Botts L.L.P.

Respectfully submitted,

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